

Application No. 10/567,892
Reply to Office Action of June 9, 2009

Docket No.: 209546-103493

REMARKS

Claims 1-8 and 10-17 are pending in this application and stand finally rejected. By this paper, no claims have been amended, cancelled or added. Favorable reconsideration is respectfully requested in light of the foregoing amendments and the following remarks.

I. Disqualification of Prior Art

Applicant acknowledges the rejection of claims 1-17 at page 2 of the Action under 35 U.S.C. §103(a) over U.S. 2003/0141005 to Donatti et al. ("Donatti") in view of U.S. 2008/0135167 to Simmons et al. ("Simmons"). As will be explained in the foregoing remarks, Applicant hereby submits that Donatti should be disqualified as applicable prior art. As such, the rejection of claims 1-17 would not be supported and should be withdrawn. Claims 1-8 and 10-17 would therefore be allowable over the applied art of record.

A. Rationale For Disqualifying Prior Art

As is known, when a claim is rejected under 35 U.S.C. §103(a), the prior art relied-upon by the Office may be disqualified if the prior art qualifies *only* under one or more of 35 U.S.C. §§102(e), (f) and (g). For convenience, Applicant reproduces the following from M.P.E.P. 706.02(l)(1), 8th Ed., 7th Rev. (July, 2008):

**706.02(l)(1) Rejections Under 35 U.S.C.
103(a) Using Prior Art Under
35 U.S.C. 102(e), (f), or (g);
Prior Art Disqualification
Under 35 U.S.C. 103(c) [R-6]**

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

Further, Applicant acknowledges the following from M.P.E.P. 706.02(l)(1), I., 8th Ed., 7th Rev. (July, 2008), which states the following:

The burden of establishing that subject matter is disqualified as prior art is placed on applicant once the examiner has established a *prima facie* case of obviousness based on the subject matter. For example, the fact that the reference and the application have the same assignee is not, by itself, sufficient evidence to disqualify the prior art under 35 U.S.C. 103(c). There must be a statement that the common ownership was "at the time the invention was made."

Accordingly, in summary, when an Applicant asserts a claim of 'prior art disqualification,' Applicant acknowledges that the following fundamentals must exist in order to assert such a claim:

- the applied prior art qualifies only under one or more of 35 U.S.C. §§102(e), (f) and (g),
- the applied prior art & application must have common ownership (i.e., the same assignee), and
- the applied prior art & application must have common ownership at the same time the invention was made.

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B. Prior Art Qualifying Only Under One or More of 35 U.S.C. §§102(e), (f) or (g)
Referring to M.P.E.P. 706.02, 8th Ed., 7th Rev. (July, 2008), Applicant brings the following to the Office's attention:

706.02 Rejection on Prior Art [R-6]

35 U.S.C. 102. Conditions for patentability; novelty and loss of rights to patent.

A person shall be entitled to a patent unless —

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or
- (f) he did not himself invent the subject matter sought to be patented, or
- (g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Further, section VI., (D) of M.P.E.P. 706.02, 8th Ed., 7th Rev. (July, 2008) indicates the following:

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VI. < DETERMINING THE EFFECTIVE FILING DATE OF THE APPLICATION

The effective filing date of a U.S. application may be determined as follows:

(D) If the application properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application.

Applicant acknowledges that Donatti's date of *publication* is July 31, 2003. Applicant also acknowledges that the *provisional* filing date of the present application is August 14, 2003 (i.e., Donatti's publication date precedes the present application's effective filing date by only about two weeks). Accordingly, when looking to M.P.E.P. 706.02, 8th Ed., 7th Rev. (July, 2008), it will be appreciated that the previous, October 15, 2008 *Non-Final* rejection of the claims under 35 U.S.C. §102(b) was *improper*, and, as such, any rejection relying on a "more than one-year publication bar" would be unsupported. Further, it appears that application of Donatti as prior art under one or more of 35 U.S.C. §§102(a), (c) or (d) would also be unsupported.

Thus, in view of the above remarks, it appears that any potential to apply Donatti against the claims of the present invention could be done so under only one or more of 35 U.S.C. §§102(e), (f) or (g), with a rejection under 35 U.S.C. §§102(e) being the likely rejection due to the fact that Donatti is a published patent application.

Thus, Applicant hereby submits that the "first prong" of the disqualification analysis has been met.

C. The Prior Art & Present Application Having Common Ownership

Although no assignment papers have been filed heretofore in the present application, Applicant submits that: (a) the present application is owned by the following company, and/or (b) the inventor of the present application has an obligation of assignment of the present application to the following company: Magna International of America, Inc.. Further, although no assignment papers were filed for Donatti, Applicant provides the following patent family data from the online, commercial patent search service, www.delphion.com in order to establish a relationship of common ownership by Magna of the present application and Donatti:

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As seen above, one of the corresponding patent family members with Donatti (i.e., U.S. 20030141005A1) is a published, international patent application (i.e., WO0064706A1). Shown below is a portion of the cover page of WO0064706A1, which indicates that "Magna Interior Systems, Inc." is the assignee of record.

PCT WORLD INTELLECTUAL PROPERTY ORGANIZATION  International Bureau							
INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)							
<p>(51) International Patent Classification 7:</p> <p>B60R 13/02, B29C 44/12</p>	<p>AI</p>						
<p>(11) International Publication Number: WO 00/04706</p>							
<p>(13) International Publication Date: 2 November 2000 (02-11-00)</p>							
<p>(21) International Application Number: PCT/CA00/0084</p>							
<p>(22) International Filing Date: 12 April 2000 (12-04-00)</p>							
<p>(30) Priority Data:</p> <table style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 30%;">60/130,557</td> <td style="width: 30%;">22 April 1999 (22-04-99)</td> <td style="width: 10%; text-align: center;">US</td> </tr> <tr> <td>60/132,765</td> <td>6 May 1999 (06-05-99)</td> <td style="text-align: center;">US</td> </tr> </table>		60/130,557	22 April 1999 (22-04-99)	US	60/132,765	6 May 1999 (06-05-99)	US
60/130,557	22 April 1999 (22-04-99)	US					
60/132,765	6 May 1999 (06-05-99)	US					
<p>(71) Applicant: MAGNA INTERIOR SYSTEMS, INC. (CA/CA); 337 Magna Drive, Aurora, Ontario L4G 7K1 (CA).</p>							
<p>(72) Inventor: DONATTI, Joseph, T.; 4696 Sallandow Drive, Howell, MI 48843 (US); LATMIA, Amal, R.; 2704 Apache Trail, Wixom, MI 48393 (US); HERBERT, Jamie, Marisa; 341 Fowlerville, Pontefract, ON K0J 3G6 (CA).</p>							
<p>(74) Agent: JMAI, Jeffrey, T.; Magna International Inc., 337 Magna Drive, Aurora, Ontario L4G 7K1 (CA).</p>							
<p>Published With international search report. Before the expiration of the time limit for amending the claims and to be republished in the event of the receipt of amendments.</p>							
<p>54) Title: VEHICLE HEADLINER INCLUDING A POLYURETHANE SUBSTRATE AND MULTI-LAYERED LAMINATE, AND METHOD OF MAKING THE SAME</p>							

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Further, as seen above, there is evidence that Donatti is owned by *Magna* by virtue of the fact that both WO0064706A1 and Donatti claim priority to the same U.S. Provisional Patent Application documents (i.e., serial nos. 60/130,557 and 60/132,765).

As such, for at least the above reasons, Applicant hereby submits that "*Magna*" is and was the common owner of both the present application and Donatti. Although "*Magna International of America, Inc.*" and "*Magna Interior Systems, Inc.*" are not, verbatim, the same spelling of the assignee, Applicant hereby submits that both names do, in fact, point to the same owner. If the Office wishes to challenge the above claim, Applicant will provide an Affidavit in a subsequent communication per M.P.E.P. 706.02(l)(2), II.(C), I., 8th Ed., 7th Rev. (July, 2008), as follows:

application being examined. As mentioned above, applicant(s) may submit, *in addition to* the above-mentioned statement regarding common ownership, the following objective evidence:

(A) Reference to assignments recorded in the U.S. Patent and Trademark Office in accordance with 37 CFR Part 3 which convey the entire rights in the applications to the same person(s) or organization(s);

(B) Copies of unrecorded assignments which convey the entire rights in the applications to the same person(s) or organization(s) are filed in each of the applications;

(C) An affidavit or declaration by the common owner is filed which states that there is common ownership and states facts which explain why the affiant or declarant believes there is common ownership, which affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization when the common owner is a corporation or other organization; and

(D) Other evidence is submitted which establishes common ownership of the applications.

Thus, in view of the above remarks, Applicant hereby submits that the "second prong" of the disqualification analysis has been met.

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D. Prior Art & Present Application Having Common Ownership *At The Same Time* The Invention Was Made

In accordance with M.P.E.P. 706.02(l)(2), II., 8th Ed., 7th Rev. (July, 2008), Applicant notes that following:

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(c), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

"Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

As such, Applicant hereby submits that present:

"Application 10/567,892 and Donatti were, at the time the invention of Application 10/567,892 was made, owned by Magna International of America, Inc."

Thus, in view of the above remarks, Applicant submits that the "third prong" of the disqualification analysis has been met.

II. Rejections Under 35 U.S.C. § 103(a)

Claims 1-8 and 10-12 stand rejected as being obvious under 35 U.S.C. §103(a) over Donatti in view of Simmons. In light of the following remarks, the rejection is respectfully traversed.

A. Disqualification of Prior Art

In view of the remarks provided above in section I. of this paper, Applicant hereby submits that Donatti is disqualified as prior art under 35 U.S.C. §103(a). For at least this reason alone, the present rejection of the claims is not supported. Claims 1-8 and 10-12 are allowable over the prior art. Withdrawal of the rejection is hereby requested.

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B. Donatti / 35 U.S.C. §102(e)

Because Donatti is disqualified as prior art under 35 U.S.C. §103(a), if the Office chooses to apply the teachings of Donatti against the claimed invention alone under 35 U.S.C. §102(e), Applicant hereby reproduces, for convenience, the Examiner's remarks at page 8 of the present, Final Office Action:

Donatti et al. teach all the required layers but lack the teaching of weight percentages that applicant desires. This is remedied by Simmons et al.

As such, Applicant hereby submits that the Office's remarks has precluded Donattit's teachings from being applied against the claims in order to indicate that Donatti's teachings *anticipates* the claimed invention under 35 U.S.C. §102(e). For at least the above reasons, Applicant preemptively submits that a rejection of the claims under 35 U.S.C. §103(a) with Donatti's teachings would be overcome.

C. Donatti & Simmons

Applicant has reviewed the Office's remarks in the present Action and submits that the Office has only added new remarks to advance prosecution on the merits at pages 8-9 of the present Action. At pages 8-9, the Office has attempted to support Donatti's deficiencies by pointing to Simmons. Applicant respectfully disagrees for the foregoing reasons.

Regarding Independent Claim 1

Applicant submits that any permissible combination of Donatti with Simmons would not render the claimed invention obvious. Independent claim 1 is therefore allowable. Claims 2-8 and 10-12 depend directly or indirectly from independent claim 1 and are also allowable.

Regarding Independent Claim 13

Applicant submits that independent claim 13 was added in response to the previous, Non-Final Office Action. Applicant notes that although the Office has provided several pages of remarks at pages 2-9 of the present Action, the Office has not identified each claim individually by number with a column, line or Figure number in one or more of Donatti and Simmons to support such a rejection. Particularly, a specific mention of a "first reinforcement layer" and a "second reinforcement layer" arranged on each side of the core layer (see, e.g., claim 13) is *noticeably absent* in the remarks asserted by the present, Final Action.

In view of the above remarks, Applicant hereby submits that claim 13 is allowable over any permissible combination of the art of record. Further, if the Office believes that a

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permissible combination of the art of record may support a rejection of one or more of claims 1 and 13, Applicant hereby requests that the Office sets forth a rejection calling out independent claims 1 and 13 *individually* by name and pointing to a specific column, line or Figure number in the art of record in order to *clearly articulate* the rationale for such a rejection, per M.P.E.P. 2143, A., 8th Ed., 7th Rev. (July, 2008) and M.P.E.P. 2141, III., 8th Ed., 7th Rev. (July, 2008), which are provided below for convenience:

2143 >Examples of< Basic Requirements of a *Prima Facie* Case of Obviousness

A. Combining Prior Art Elements According to Known Methods To Yield Predictable Results

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(emphasis added), and

2141 >Examination Guidelines for Determining Obviousness Under< 35 U.S.C. 103 [R-6]**

III. RATIONALES TO SUPPORT REJECTIONS UNDER 35 U.S.C. 103

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. Exemplary rationales that may support a conclusion of obviousness include:

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(emphasis added).

In closing, Applicant petitions the Examiner to contact the undersigned before maintaining a rejection so as to explore any deficiencies that may be overcome in an expedited and efficient manner.

Conclusion

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3145, under Order No. 209546-103493 from which the undersigned is authorized to draw.

Dated: 8/10/09

Respectfully submitted,

By _____

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